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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent Application of

Robert NOODELIJK

Group Art Unit:1661

Serial No.: 09/923,534

Examiner: Anne Marie Grünberg

Filed: August 8, 2001

For: CHRYSANTHEMUM PLANT NAMED 'ETNA'

REPLY BRIEF

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Appellant replies to the Examiner's Answer mailed April 20, 2004 as follows.

The driving consideration in this case is whether sales abroad properly can be combined with an admittedly non-enabling publication to make that publication enabling. If the sale or use relied upon in the rejection was in this country, appellant would not be taking the position he has during the course of prosecution here.

Appellant's dispute is with what the publication is being combined. The Brief on Appeal contains no attack on the publication as a non-domestic publication; the attack relates to the reliance upon sales outside the United States which, with respect, do not constitute a patent-defeating act under 35 USC 102(b). It remains appellant's position that the rejection is based upon a combination of pieces of evidence, neither of which standing alone, meets the definition of prior art under 35 USC 102(b). Two pieces of evidence, neither of which is proper prior art under 35 USC 102(b) cannot properly be combined magically to become a proper rejection under 35 USC 102(b).

Appellant also maintains that the Donohue holding does not permit one to combine something admittedly non-enabling with something that is not de jure prior art for a proper rejection;

both references relied upon in that case qualified as prior art under 35 USC 102(b). The sale abroad of the plant does not provide enablement in this context. It is recognized that the Solicitor of the USPTO argued before a panel of the United States Court of Appeal for the Federal Circuit on April 9, 2004 in two appeals involving rejections under 35 USC 102(b) using the same rationale as here that the sales in those cases were relied upon to prove enablement. Appellant respectfully disagrees. If the law says (and it does) that use or sale abroad is not a patent-defeating act, one may not properly take that same evidence and create out of whole cloth a newly allegedly permissible category to justify the rejection.

Appellant also disagrees absolutely with the statement in the last sentence of the paragraph bridging pages 6 and 7 of the Examiner's Answer that the second clause of 35 USC 102(b) "is not relevant" because the rejection is based upon printed publications. The articulation of the rejection shows that the sale abroad of the plant is used as the enabling element of the rejection. The clause is highly relevant and indeed proves the error in the rejection.

It was also asserted at page 8 of the Examiner's Answer (see the last three sentences of the paragraph bridging pages 7 and 8)

that the Court in In re LeGrice had no evidence before it of public availability of the plant. Appellant respectfully disagrees. See, for example, the noted disclosures in the left-hand column of page 368 of the opinion indicating that the rose Dusky Maiden was "raised and exhibited" and noting the "Raiser and Distributor" of the rose Charming Maid. In re LeGrice does not provide authority for the USPTO position here. It is noted also that Judge Clevenger during the April 9, 2004 hearings mentioned above stated his belief that there was an awareness of plant sales (abroad) by the Court of Customs and Patent Appeals in In re LeGrice.

Moreover, the position taken by the USPTO in a rejection of this type is believed to violate the UPOV Convention.

Chapter III, Article 6 of the UPOV Act of 1991 includes the following:

(1) Criteria-the variety shall be deemed to be new if, at the time of filing the application for a breeders' right, propagating or harvested material of the variety has not been sold or otherwise disposed to others, by or with consent of the breeder, for purposes of exploitation of the variety (i) in the territory of the contracting party in which the application has been filed earlier than one year before that date and (ii) in a territory other than that of the contracting party in which the application has been filed earlier than four years or in the case of trees and vines, earlier than six years before that date. (Emphasis added.)

In the present case, the U.S. filing date was August 8, 2001, and the first offer for sale abroad was in December 1999. Thus, 'Etna' meets the criteria for novelty in the UPOV 1991 Act to be eligible for a PBR grant in the USA. It is believed that the same criteria should be applied to plant patents and the claim is patentable for this and the other reasons presented.

For the reasons presented in the Brief on Appeal filed January 13, 2004 and the additional arguments herein, it is respectfully submitted that the rejection under 35 USC 102(b) is improper and the Board is asked to rule accordingly.

Respectfully submitted,

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June 21, 2004
Date

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